

Stadlmayr

Claims 1-5, 7, 9-17, and 23 stand rejected under 35 U.S.C. §102(b), as being anticipated by DE 2,124,684 ("Stadlmayr"). Applicant respectfully traverses this rejection, since Stadlmayr does not disclose each and every element required by these claims.

In particular, the Examiner concluded that the Fig. 3 embodiment of Stadlmayr can be configured to assume different active and common configurations, and because the term "configurable" is intended use, the claims would read on these configurations. However, the term "configurable" is not intended use language, but rather functional language that must be given patentable weight.

Notably, the MPEP specifically allows functional language, stating:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

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A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (See MPEP §2173.05(g)).

In the instant case, independent claim 1 requires the two electrode elements and the other electrode to be configurable as two bipolar electrode pairs, with the other electrode element being common to the bipolar electrode pairs. There is no explicit or implicit disclosure in Stadlmayr that the middle electrode array is common to two bipolar electrode pairs respectively comprising the proximal and distal electrode arrays of the Fig. 3 embodiment. Significantly, there is no disclosure that the connector 3 of the Fig. 3

embodiment is designed in a manner that, when coupled to an RF generator, could configure the electrode arrays in the manner required by independent claim 1.

Thus, Applicant submits that claims 1-5, 7, 9-17, and 23 are not anticipated by Stadlmayr, and as such, respectfully request withdrawal of the §102 rejection of these claims.

Mahvi

Claims 1-5, 7, 9-17, 23, 25-30, 32, 34-39, and 41-46 stand rejected under 35 U.S.C. §102(b) or 35 U.S.C. §103(a) as being anticipated by, or in the alternative, obvious over, U.S. Patent Publication No. 2002/0022864 ("Mahvi"). Applicant respectfully traverses these rejections, since Mahvi does not disclose, teach, or suggest the combination of elements required by these claims.

Turning first to the anticipation rejection, the Examiner has again concluded that the term "configured" is intended use language that should not be given patentable weight with respect to Mahvi. However, as with Stadlmayr, there is no explicit or implicit disclosure in Mahvi that the middle electrode array 22a is common to two bipolar electrode pairs respectively comprising the proximal electrode array 22b and the distal electrode array 22c of the Fig. 7 embodiment. Significantly, there is no disclosure that the connectors 24 of the respective probe assemblies are designed in a manner that, when coupled to an RF generator, could configure the electrode arrays in the manner required by independent claim 1.

It should also be noted that independent claim 25 requires "a controller for configuring the two electrode elements and other electrode element as two bipolar

electrode pairs, wherein the other electrode element is common to the bipolar electrode pairs." There is no disclosure in Mahvi that the controller 56 is capable of performing this function. Notably, such functionality of the controller 56 does not depend on its intended use, since the controller 56 must be specifically designed to perform this function in order for it to include this element. Independent claim 37 is a method claim, and thus, the concept of "intended use" clearly does not apply to it.

With respect to the obviousness rejection, the Examiner stated that "it would have been obvious to the skilled artisan to render the middle electrode as the common electrode since the reference clearly teaches larger lesion volumes are desired and such connection would inherently accomplish the same." First, as discussed above, the Fig. 7 embodiment of Mahvi simply does not inherently result in the claim invention. Second, the fact that Mahvi discloses the problem to be solved by the claim invention—i.e., creating larger lesion volumes, does not mean that every solution to that problem would be obvious, including the solution solved by the claimed invention. There is nothing in Mahvi that suggests to one of ordinary skill in the art that the middle electrode array be configured as common electrode to two separate bipolar electrode pairs.

As stated in the previous response, the claimed invention uses a common electrode element between two electrode elements to create two bipolar electrode arrangements, each of which is more closely spaced than if electrical energy were to be conveyed between the two electrode elements. That is, by adding an electrode element, the distance that the electrical energy needs to travel from each of the two electrode elements to the common electrode element will be equal to one-half the spacing between the two electrode elements, thereby effectively cutting the distance that the electrical energy has to travel

between electrode elements in half. (See page 15, line 21 to page 16, line 3 of the specification). As a result, the ablation process is made more efficient. (See page 21, lines 15-20).

Thus, Applicant submits that claims 1-5, 7, 9-17, 19, 23, 25-30, 32, 34-39, and 41-46 are not anticipated or obvious over Mahvi, and as such, respectfully request withdrawal of the §102, 103 rejections of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

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